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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,476	12/21/2000	Guocun Chen	60,137-161	9031

26096 7590 08/15/2003

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EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

11

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,476

Applicant(s)

CHEN, GUOCUN

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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1. The rejections based on 35 USC 112 and 103 have been withdrawn based on the applicant's amendments and arguments. However, double patenting rejections have been added in the present action. Also, the amendment has added new matter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to claims 1 and 8 changed the nitrogen content from about 6-45 atomic percent to from about 6-4 atomic percent, although this does not seem to be the intent of the applicant. This rejection will be withdrawn if the claims are amended to cite the original nitrogen content range of 6-45%. For the purposes of this Office action, the examiner treats the claims as having the original nitrogen content range of 6-45%.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/033859. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cite a substantial overlap of subject matter. The copending claims anticipate the present claims, since the copending claims are narrower in scope. The copending claims differ from the present claims by specifying a vapor deposited layer and a vapor deposition pressure. The present claims encompass such a claim. Also, the copending claims specify the multi-layer coating to have an appearance of nickel but do not specify that the metal compound layer should provide the nickel appearance. Since both sets of claims cite the same metal compound layers, it is the examiner's position that the copending metal compound layer would inherently possess the presently claimed nickel appearance.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 09/827189. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cite a substantial overlap of subject matter. The copending claims anticipate the present claims, since the copending claims are narrower in scope. The copending claims differ from the present claims by specifying a different nitrogen content range, including an extra metal compound species, and citing an appearance of stainless steel. The present claims encompass such a claim. The nitrogen content range overlaps the present claims from 6 to 22 atomic percent, anticipating the presently claimed range. Also, the copending claims recite the use of refractory metal nitride or refractory metal alloy nitride, which anticipates the claims. Although the copending claims cite an appearance of stainless steel, it is the examiner's position that this color would be equivalent to nickel color. Also, since both sets of claims cite the same metal compound layers, it is the examiner's position that the copending metal compound layer would inherently possess the presently claimed nickel appearance.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-14 of copending Application No. 10/033941. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because they cite a substantial overlap of subject matter. The copending claims anticipate the present claims, since the copending claims are narrower in scope. The copending claims differ from the present claims by specifying a different nitrogen content range, including an extra metal compound species, citing an appearance of stainless steel, and a vapor deposited layer. The present claims encompass such a claim. The nitrogen content range overlaps the present claims from 6 to 22 atomic percent, anticipating the presently claimed range. Also, the copending claims recite the use of refractory metal nitride or refractory metal alloy nitride, which anticipates the claims. Although the copending claims cite an appearance of stainless steel, it is the examiner's position that this color would be equivalent to nickel color. Also, since both sets of claims cite the same metal compound layers, it is the examiner's position that the copending metal compound layer would inherently possess the presently claimed nickel appearance.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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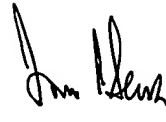
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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb
August 4, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700